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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,841	05/09/2001	Adam McCluskey	PM099750	8785

7590 05/07/2003  
Pillsbury Winthrop  
50 Fremont Street  
San Francisco, CA 94105-2228

EXAMINER

OWENS, AMELIA A

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/07/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicant(s)

09/743,841

Applicant(s)

MCCLUSKEY ET AL.

Examiner

Amelia A. Owens

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 30-51 is/are pending in the application.
- 4a) Of the above claim(s) 7-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 26, 30, 32, 35, 45, 47 and 49 is/are rejected.
- 7) ☒ Claim(s) 31, 33, 34, 36-44, 46, 48, 50 and 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Claims 27-29 have been canceled. New claims 30-51 have been added.

Claims 1-26 and 30-51 are pending.

Upon reconsideration the restriction has been modified as follows:

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 26, 27-29, drawn to cell permeable inhibitor of phosphatase.

Group II, claim(s) 7-16, drawn to compounds, method of making same and method of using same.

Group III, claim(s) 17-20, drawn to method of sensitizing cancer cells.

Group IV, claim(s) 21-25, drawn to method of screening compounds.

*Note that group I now includes claims 4-6 and 26. The elected invention includes claims 1-6, 26, 30-51. Claims 7-25 remain withdrawn.*

The indicated allowability of claim 1-3 is withdrawn in view of the newly discovered reference(s) to Poss et al; Uebele et al; and Sprague as well as Walter and Laidly et al already of record. Rejections based on the reference(s) follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 30, 32, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Laidley et al.

Laidley et al demonstrate the inhibitory activity of cantharidin analogues against protein phosphatase 2A. See abstract and figure 1 at page 1153.

Claims 4, 47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter.

Walter at page 66 formula 2, 5a, and 5b teach compounds according to the invention. Walter also teach the compounds having antitumor properties according to claims 47 and 49.

Claims 4-6, 26, 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Sprague USP 4,228,180; and Uebele et al USP 3,954,913; and Poss et al USP 5,399,725 *each alone*.

Sprague at column 2 teach species according to claims 4 and 26. See formula III, IV and V. See column 1 line 58 – column 2 line 24 teach a process for preparing cell permeable inhibitor according to claim 45 by reacting a furan.

Uebele et al at column 11/12 examples 5 and 7; at column 13/14 example 8 teach species according to claims 4 and 26.

Poss et al at column 7 formula IX teach species according to claims 4-6.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Uebele et al.

Uebele et al generically teach compounds according to the invention. See Column 1 structure II when Y = oxygen; Z = CH<sub>3</sub>.


One of ordinary skill in the art would thus be motivated to prepare compounds from under the Uebele et al genus in order to obtain additional stabilizers. Also, one of ordinary skill in the art would be motivated to prepare compounds structurally similar to those of Uebele et al in the expectation of obtaining a useful stabilizer compound as compounds structurally similar in structure are expected to have similar properties. The level of skill in the art is further reflected in In re Lohr 137 USPQ 548 at 549 (CCPA 1963), and in In re Payne 204 USPQ 249 at 254 (CCPA 1979).

Claims 31, 33, 34, 36-44, 46, 48, 50, 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 703-308-4707. The examiner can normally be reached on Monday - Friday from 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan L. Rotman can be reached on 703-308-1235. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Amelia A. Owens  
Primary Examiner  
Art Unit 1625

ao  
May 2, 2003

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Art Unit: 1625

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